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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,220	12/30/2003	Jae-Sik Choi	11038-132-999	1484
24341	7590	08/12/2005	EXAMINER	
MORGAN, LEWIS & BOCKIUS, LLP. 2 PALO ALTO SQUARE 3000 EL CAMINO REAL PALO ALTO, CA 94306			PHAM, MINH CHAU THI	
			ART UNIT	PAPER NUMBER
			1724	

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/749,220

Applicant(s)

CHOI, JAE-SIK

Examiner

Minh-Chau T. Pham

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/15/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by either the Great Britain Patent (GB 2,275,768 A) or the German Patent (DE 4021460 A1).

The Great Britain reference teaches an air intake (10) comprising a port with a cross-section of a rectangular shape (see Fig. 2), and a cuttable groove formed on the wall of the port (see details of Figs. 1 & 2) for inserting an air filter (12) into the air intake duct (10) through a hole formed by cutting out the groove (see details of Figs. 1 & 2, page 3, first paragraph). The German reference teaches an air intake (11) comprising a port with a cross-section of a rectangular shape (see Fig. 2), and a cuttable groove (7) formed on the wall of the port (see details of Figs. 1 & 2) for inserting an air filter (10) into the air intake duct (11) through a hole formed by cutting out the groove (see details of Figs. 1 & 2).

Regarding to the numerical requirements, i.e. "the cuttable groove is dug in $\frac{3}{4}$ in relation to the wall thickness" of claims 3, 7 and 10, the specification contains no disclosure of either the critical nature of these requirements or any unexpected results arising therefrom, and as such these requirements would be arbitrary and therefore obvious. Applicant must show that these requirements are critical. *In re Woodruff*, 16 USPQ 2d 1934.

Response to Amendment

Applicant's arguments filed on May 20, 2005 have been fully considered but they are not persuasive.

Applicant argues that the cited reference Esaki does not teach "the use of a cuttable groove that is formed at an external wall of the air port for inserting an air filter into the air intake duct through a hole formed by cutting out the groove". The Examiner now drops Esaki and newly introduces the Great Britain reference and the German reference to show: The Great Britain reference teaches an air intake (10) comprising a port with a cross-section of a rectangular shape (see Fig. 2), and a cuttable groove formed on the wall of the port (see details of Figs. 1 & 2) for inserting an air filter (12) into the air intake duct (10) through a hole formed by cutting out the groove (see details of Figs. 1 & 2, page 3, first paragraph), as claimed. The German reference teaches an air intake (11) comprising a port with a cross-section of a rectangular shape (see Fig. 2), and a cuttable groove (7) formed on the wall of the port (see details of Figs. 1 & 2) for inserting an air filter (10) into the air intake duct (11) through a hole formed by cutting out the groove (see details of Figs. 1 & 2), as claimed. It is clear from these 2 references that the opening is formed along a cuttable groove by cutting. A person skilled in the art in the field of the ventilation of vehicles, in order to insert an air filter into the air intake duct, would compellingly to provide an opening at the external wall, i.e. by cutting. In order to simplify one's work and to create a regular cutting, one will provide a groove, a channel or anything like that prior to the cutting process.

Applicant's arguments with respect to claims 1-10 have been thoroughly considered but are moot in view of the new ground(s) of rejection, as discussed above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh-Chau T. Pham whose telephone number is (571) 272-1163. The examiner can normally be reached on Mon/Tues/Thur/Fri 7:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Minh-Chau Pham
Patent Examiner
Art Unit: 1724
August 9, 2005